

REMARKS

Claims 18-23, 26-30, 36-40 and 42-43 remain in this application, with Claims 18 and 20 amended. Applicants respectfully request entry of the foregoing claim amendments in order to place the application in better form for appeal.

As will be further discussed below, Applicants consider all claims to be in condition for allowance. A Notice of Appeal is submitted concurrently with this paper. While Applicants are prepared to pursue an appeal of the final rejection, Applicants remain hopeful that this response will demonstrate the patentability of all claims and thereby obviate the need for appeal. At a minimum, Applicants request that the Examiner issue an Advisory Action indicating that the proposed amendments will be entered for purpose of consideration on appeal.

The Examiner rejected Claims 18-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner objected to the term "microscopic particles" as new matter and undefined. Applicants respectfully disagree. While the exact phrase may not have been used in the specification, the teaching was nevertheless fully disclosed in the application. For example, the specification refers to the removal of the remains of organisms such as insects and bacteria (see, e.g., page 9, lines 13-15), and persons having ordinary skill in the art would understand that such remains would constitute microscopic particles. Websters' Ninth Collegiate Dictionary defines microscopic as "invisible or indistinguishable without the use of a microscope," which accurately describes the scale of the particles at issue in the patent application.

Nevertheless, in the interest of resolving outstanding issues prior to appeal, Applicants have amended Claims 18 and 20 to remove and/or modify the objected term. No new matter has been added to the claims. Applicants request entry of the amendments for consideration on appeal, as discussed above.

The Examiner rejected Claims 18-23, 26-30 and 36-43 under the judicially-created doctrine of obviousness-type double patenting over Claims 1-8 of U.S. Patent

No. 6,327,812. Applicants enclose a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c), which is deemed sufficient to obviate this ground of rejection.

The Examiner rejected Claims 18-23, 26-30, 36-40 and 42-43 under 35 U.S.C. § 103(a) as unpatentable over Forbes and Montellano. This is the same ground of rejection as raised previously, and Applicants stand on the arguments presented in its previous response. Applicants consider the argument and evidence of record already sufficient to rebut the *prima facie* conclusion of obviousness. Rather than repeat the previous argument, Applicants will instead address certain points raised by the Examiner in an attempt to either convince the Examiner to withdraw the rejections or establish a sufficient record for appeal.

First, the Examiner asserts that there is no showing that others of ordinary skill in the art were working on the problem. However, the long-felt need coupled with the presence of other methods of contamination eradication shows that others in the art have been working on the problem. In fact, Forbes' patent is evidence that a long-felt need for eradication methods exists and that others of ordinary skill in the art were working on the problem. As further discussed below, Applicants enclose further evidence showing that persons of ordinary skill in the art were actively engaged in studying the problem addressed by the invention.

Second, the Examiner argues that Claim 18 does not relate to Geyer's declaration because it does not state "HEPA filter." However, Claim 19 plainly describes the extracting step claimed in Claim 18 as using a HEPA filter and is directly pertinent to Geyer's declaration. The Examiner also asserts that the certain organisms, such as microorganisms from mold, are not covered by the claims. In fact, Claims 23 and 30, which the Examiner uses as examples, do not limit what types of particulates are filtered and persons skilled in the art would recognize the invention as having applicability to such organisms.

Third, the Examiner asserts that the metallic cloth described by Montellano to catch insects will also catch airborne microorganisms. This assertion is without merit

because there is no evidence that even if the "metallic cloth would look like cloth," it would be able to remove airborne particulates like the air filtration defined in the Applicants' claim. Plainly, filters like HEPA filters use much more complex technology than a simple net or metal cloth. Further, there is no evidence that the method to catch bugs claimed by Montellano would work to filter airborne particulate matter as claimed by Applicants. In fact, as pointed out by the Examiner, in our experts' opinions, the method claimed by Montellano to catch bugs would be ineffective in removing smaller allergens.

To further demonstrate the non-obviousness of the claims, Applicants submit herewith the Declaration of Dr. Sean Abbott and the Declaration of Larry Chase. The declarations present compelling objective evidence to show that the proposed combination would not have been obvious to one of ordinary skill, demonstrating, among other things: long-felt but unmet need, commercial success, and recognition of others. In the following sections, various objective criteria demonstrating non-obviousness of the invention are indexed to the Declarations of Dr. Abbott and Mr. Chase, for the Examiner's convenience. The Examiner is referred to the original evidence in the Declarations themselves, which for the sake of brevity will not be repeated here.

Long-felt but Unmet Need: Dr. Abbott attests to the fact that traditional methods to treat buildings contaminated by mold, bacteria, termites, dust mites, and other microorganisms are insufficient and may actually create a corresponding problem of increased bioaerosol particulate matter. (Abbott, ¶ 4.) In his declaration, Dr. Abbott refers to a publication in the Journal of Aerosol Science reporting that homes reclaimed from flood damage had significantly increased airborne microorganism levels. (Abbott, ¶ 8.) He also refers to a peer-reviewed publication in the Atmospheric Environment that specifically discusses the health implications of inhaling indoor aerosols. (Abbott, ¶ 14.) Neither reference suggests the desirability of filtration in conjunction with eradication using heated gas.

Commercial Success: Mr. Chase attests to the commercial success of the invention. (Chase, ¶ 2, 4-10.) This success has a nexus to the claims of issue, because the claimed combination of thermal eradication and micro-filtration, is widely adopted under the commercial name ThermaPureHeat™.

Recognition by Others: Mr. Chase attests to the recognition by others the invention has received. (Chase, ¶ 2, 4, 11-12.) In fact, the process set forth in the claims has been named "Best New Product" by the National Society of Professional Engineers. (Chase, ¶ 4.)

In view of the foregoing, the Applicants respectfully submit that Claims 18-23, 26-30, 36-40, and 42-43 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. If it would be helpful to placing this application in condition for allowance, the Applicants encourage the Examiner to contact the undersigned counsel and conduct a telephonic interview.

Serial No. 10/014,727
June 9, 2006
Page 10

To the extent necessary, Applicants petition the Commissioner for a two-month extension of time, extending to July 7, 2006, the period for response to the Office Action dated February 7, 2006. Our check in the amount of \$540.00 is enclosed for the two-month extension of time pursuant to 37 CFR § 1.17(a)(2), \$250.00 for the Notice of Appeal and \$65.00 for the Terminal Disclaimer pursuant to 37 CFR § 1.20(d). The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



Date: June 9, 2006

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Enclosures:

1. Declaration of Larry Chase
2. Declaration of Sean Abbott
3. Notice of Appeal
4. Terminal Disclaimer